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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Phan, et al.)
)
Appl. No.: 10/087,549)
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Filed: February 28, 2002)
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For: METHODS FOR DECREASING)
NON-SPECIFIC BINDING OF)
BEADS IN DUAL BEAD ASSAYS)
INCLUDING RELATED OPTICAL)
BIODISCS AND DISC DRIVE)
SYSTEMS)
)
Examiner: Diana B. Johannsen)
)
Group Art Unit: 1634)

PETITION TO FILE DECLARATIONS ON BEHALF OF NONSIGNING INVENTORS WHO
REFUSE TO SIGN OR CANNOT BE REACHED UNDER 37 CFR 1.47(A)

Mail Stop Petition

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed April 27, 2004, Applicants hereby petition under the provisions of 37 C.F.R. § 1.47(a), that the Commissioner accept for filing and examine the above-identified patent application despite the fact that the Oath/Declaration filed on July 15, 2002, includes a non-initialed, non-dated alteration of inventor KaYuen Yeung's address. Applicants have been unable to secure another oath/declaration from KaYuen Yeung despite diligent efforts and numerous requests on behalf of the inventors who have executed declarations. In support for this petition, Applicants provide the following:

11/02/2004 WABDELRI 00000002 10087549

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130.00 DP

DECLARATION OF INVENTORSHIP

When the instant Application was filed on February 28, 2002, a Declaration of Inventorship was also filed that was executed by two of the three inventors, Brigitte Chau Phan and Amethyst Hoang Lam. On April 27, 2004, a Notice of Missing Parts was mailed indicating that a filing fee and Declaration needed to be filed in the above captioned Application. In response, another Declaration of Inventorship was submitted on July 15, 2002, that was executed by two of the three inventors, including Brigitte Chau Phan (who had signed the February 28, 2002 Declaration) and the third named inventor KaYuen Yeung (who had not signed the original Declaration submitted on February 28, 2002).

In an Office Action mailed on April 27, 2004, the Examiner notified Applicants that the July 15, 2002, Declaration was defective. In particular, the original typed address of inventor KaYuen Yeung's had been lined-out and replaced with a handwritten address. This change had not been initialed or dated. As such, the Examiner requested that a new declaration be provided.

Despite diligent efforts outlined in the attached Declaration of Jerry L. Hefner, Applicants have been unable to secure a replacement declaration from KaYuen Yeung. Applicants therefore respectfully submit that the Declarations of Inventorship filed on February 28, 2002 and July 15, 2002, which include unaltered signatures of two of the three inventors, Brigitte Chau Phan and Amethyst Hoang Lam, satisfy the requirement that all available joint inventors must (i) execute an oath or declaration on their own behalf as required by 37 C.F.R. § 1.63 and (ii) execute an oath or declaration on behalf of the nonsigning joint inventor as required by 37 C.F.R. § 1.64, and in accordance with MPEP § 409.03(a) "an oath or declaration signed by all the available joint inventors with the signature block of the non-signing joint inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor(s), unless otherwise indicated."

STATEMENTS OF FACTS

Applicant provides the following declaration, attached herewith, in support of its conclusion that KaYuen Yeung refuses to sign and/or cannot be reached:

1. Declaration of Jerry L. Hefner in Support of Petition To File Declaration On Behalf Of Nonsigning Inventors Who Refuse to Sign or Cannot Be Reached Under 37 CFR 1.47(a).

The Declaration shows the efforts of Applicants to contact KaYuen Yeung by certified U.S. Mail to obtain her cooperation. Applicants have also attempted to locate KaYuen Yeung by performing a skip trace and by requesting address service and return service via U.S. Mail. Despite these diligent efforts, Applicants have been unable to contact KaYuen Yeung or obtain an unaltered Declaration of Inventorship from her.

LAST KNOWN ADDRESS OF THE NONSIGNING INVENTORS

The last known address for KaYuen Yeung is: 1326 Third Avenue, San Francisco, CA 94122. KaYuen Yeung is a United States citizen.

CONCLUSION

Based on the foregoing, it is submitted that diligent efforts has been made to obtain an unaltered Declaration of Inventorship from KaYuen Yeung. Despite these diligent efforts, Applicants have not been able to obtain another declaration from KaYuen Yeung. Applicants submit that the remaining joint inventors, Brigitte Chau Phan and Amethyst Hoang Lam, make the application for patent on behalf of themselves and on behalf of KaYuen Yeung in accordance with 37 C.F.R. § 1.47 (a). Furthermore, Applicants respectfully submit that the Declarations of Inventorship submitted on February 28, 2002 and July 15, 2002, satisfy the requirement that all available joint inventors (i) make oath or declaration on their own behalf as required by 37 C.F.R. § 1.63 and (ii) make oath or declaration on behalf of the nonsigning joint inventor(s) as required by 37 C.F.R. § 1.64.

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Applicants respectfully request that this petition under 37 C.F.R. §1.47(a) be granted and that the Applicants be allowed to file and prosecute the above-identified patent application without an unaltered oath/declaration from KaYuen Yeung. If there are any obstacles to a prompt approval of this petition, the Patent and Trademark Office is invited to call the undersigned attorney.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 27, 2004

By: 
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